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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,892	03/31/2004	Peter N. Comley	038190/274036	5765
67141 7590 09/08/2008 ALSTON & BIRD, LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				
EXAMINER KERNS, KEVIN P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/813,892

Applicant(s)

COMLEY ET AL.

Examiner

Kevin P. Kerns

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-12, 16-23, 36, 38-42, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-23, 36, 38-42 and 46 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-12 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 and 18 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/10/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 10, and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 8 of copending Application No. 11/272,244 (also see equivalent US 2007/0102494).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective methods for diffusion bonding and superplastically forming blanks (two sheets that form a pack) to produce a structural assembly having a predetermined configuration share at least the following steps: providing the pack (first and second blanks, or sheets in a stacked configuration) comprising titanium, such that the first blank/sheet has a grain size that is at least about twice the grain size of the

second blank/sheet (including 5-8 micron for the first blank/sheet, and <2 micron, or 0.8-1.2 micron, for the second blank/sheet); diffusion bonding the first and second blanks/sheets at a diffusion bonding temperature of less than 1500°F (including 1400-1450°F); heating the pack/blanks following diffusion bonding to at least a superplastic forming temperature of the second blank/sheet; and superplastically forming the bonded blanks (including the second blank/sheet) to a predetermined configuration to form the assembly. Although independent claim 1 of the present application includes the limitation "a first and second blank comprising titanium", rather than "pack comprising first and second titanium sheets" of copending Application No. 11/272,244, it would have been obvious to one of ordinary skill in the art that these limitations are equivalent and/or obvious variants of one another. In addition, although the process steps are not in identical order, it would have been obvious to one of ordinary skill in the art to modify and/or rearrange these steps, as open-ended "comprising" language exists in the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 10-12, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisert et al. (US 4,882,823) in view of Salishchev et al. (the *Materials Science Forum* article "Characterization of Submicron-Grained Ti-6Al-4V Sheets with Enhanced Superplastic Properties" – corresponding to Cite No. 11 of the IDS dated April 21, 2004), Bampton (US 4,820,355), and Movchan et al. (WO 95/13406).

Weisert et al. disclose a method of diffusion bonding and superplastic forming hollow components such as aircraft engine components (i.e. gas turbine compressor fan blades) (col. 1, lines 5-10). Weisert et al. disclose superplastically forming "reactive" metals including titanium (col. 3, lines 49-53) and further teaches a preferred material of Ti-6Al-4V superplastically formed at general temperature ranges including 1450°F-1750°F (col. 4, lines 15-18). Weisert et al. also teach diffusion bonding the preferred Ti-6Al-4V material at 25-300 psi for about 30 minutes (col. 4, lines 19 and 28). Weisert et

al. disclose heating each blank to within a diffusion bonding temperature range of each blank (col. 4, lines 12-15), and diffusion bonding the first blank to the second blank (col. 4, lines 15-19 and 59-64). Furthermore, Weisert et al. disclose flat surfaces (14,20) positioned in abutting relation to each other to the opposite flat sides of the intermediate flat core sheet (24), and teach subjecting the sheets (12,18,24) to diffusion bonding conditions in appropriate tooling (27) to bond the flat surfaces (14,20) to each other or to the core sheet (24) other than where the stop-off material was applied, thereby forming a diffusion bonded sandwich (29) (col. 4, lines 56-64; and Figure 2B). Weisert et al. also disclose that superplastic behavior enhances formability under compressive strain conditions (col. 3, lines 47-49). Therefore, the properties and method of Weisert et al. are substantially similar with that of the applicants' claimed invention that it would be necessarily present to arrive at the specified strain rates of claims 11 and 12. However, Weisert et al. lack disclosure of specific grain sizes for the titanium blank and a diffusion bonding temperature of less than 1450°F.

However, Salishchev et al. disclose a superplastic titanium alloy (Ti-6Al-4V) that is submicron-grained (i.e. grain size of less than or about 1 micron -- see page 441, 1<sup>st</sup> paragraph under Introduction) and has enhanced superplastic properties of temperatures below 1450°F (specifically, 550°C on page 441, 1<sup>st</sup> paragraph under Introduction), with strain rates ranging from at least about  $5 \times 10^{-4}$  per second to  $1 \times 10^{-2}$  per second, such that this superplastic titanium alloy (Ti-6Al-4V) is subjected to a superplastic forming/diffusion bonding (SPF/DB) process to obtain complex-shaped components out of titanium alloys with enhanced mechanical properties, reduced

processing tool costs, and material savings due to reduced contamination (Salishchev et al.; pages 441-446; and Tables 2 and 3). Although independent claim 1 includes the limitation "the first blank has a grain size of between 0.8 and 1.2 micron and the second blank has a grain size of greater than 2 microns", it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a stacked assembly where the blanks subject to superplastic forming have widely differing grain sizes, since Bampton teaches a method of superplastic forming an assembly (Figure 7) and the desirability to provide a stacked assembly where the center sheet 13 has a very fine grain size and the two outer sheets (12,14) have a relatively coarse grain size (column 8, lines 43-51). As a result of the differing grain sizes, the center sheet may be deformed and elongated much more readily (i.e. at a lower temperature) and to a greater extent than the outer sheets (Bampton; column 8, lines 35-63).

In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed ranges through process optimization, since it has been held that there are general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify the method of diffusion bonding and superplastic forming hollow components such as aircraft engine components, as disclosed by Weisert et al., by using the superplastic titanium alloy (Ti-6Al-4V) that is submicron-grained and has enhanced superplastic properties of temperatures below

1450°F, as taught by Salishchev et al., in order to obtain complex-shaped components out of titanium alloys with enhanced mechanical properties, reduced processing tool costs, and material savings due to reduced contamination (Salishchev et al.; Abstract and Introduction of page 441; and Summary of page 446), and by further using the widely differing grain sizes of blanks to be subjected to superplastic forming to form an assembly, as disclosed/suggested by Bampton, in order to allow a sheet to be deformed and elongated much more readily (i.e. at a lower temperature) and to a greater extent than the outer sheets (Bampton; column 8, lines 35-63).

Weisert et al. in view of Salishchev et al. and Bampton lack specific disclosure of superplastically forming the titanium alloy blanks at a temperature of less than 1450°F.

However, Movchan et al. disclose superplastic deformation of titanium alloy blanks at temperatures between 650-760°C (1202-1400°F), and includes Ti-6Al-4V as an example of such a titanium alloy (Movchan et al., p. 3, lines 22-26 and p. 5, lines 28-31). Thus, it would have been obvious to arrive at a common superplastic forming temperature between 1400°F and 1450°F based on the combined disclosures of Weisert et al., Salishchev et al., Bampton, and Movchan et al. (claim 10). Movchan et al. also disclose strain rates for superplastic formation of titanium alloy of at least about  $6 \times 10^{-4}$  per second and  $1 \times 10^{-3}$  per second (Movchan et al., p. 5, lines 30-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify the method of diffusion bonding and superplastic forming hollow components such as aircraft engine components, as disclosed by Weisert et al., by using the superplastic titanium alloy (Ti-6Al-4V) that is



submicron-grained and has enhanced superplastic properties of temperatures below 1450°F, as taught by Salishchev et al., in order to obtain complex-shaped components out of titanium alloys with enhanced mechanical properties, reduced processing tool costs, and material savings due to reduced contamination, by further using the widely differing grain sizes of blanks to be subjected to superplastic forming to form an assembly, as disclosed/suggested by Bampton, in order to allow a sheet to be deformed and elongated much more readily (i.e. at a lower temperature) and to a greater extent than the outer sheets, and by further including the specified superplastic formation temperatures and strain rates, as disclosed by Movchan et al., in order to superplastically form titanium blanks at temperatures where oxidation is not a problem, inclusive of ambient atmospheres (Movchan et al.; p. 3, lines 24-26).

6. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisert et al. (US 4,882,823) in view of Salishchev et al. (the *Materials Science Forum* article "Characterization of Submicron-Grained Ti-6Al-4V Sheets with Enhanced Superplastic Properties" – corresponding to Cite No. 11 of the IDS dated April 21, 2004), Bampton (US 4,820,355), and Movchan et al. (WO 95/13406), and further in view of Stacher (US 5,118,026).

With respect to claims 5 and 6, Weisert et al., Salishchev et al., Bampton, and Movchan et al. lack disclosure of pickling the surface of the workpiece to remove any formed oxide during the superplastic forming step.

However, Stacher discloses the fabrication of titanium aluminide sandwich structures that combines the process of metal joining and superplastic forming (col. 3, lines 26-29). Stacher states that titanium is particularly sensitive to oxygen, nitrogen, and water vapor content in the air at elevated temperatures (col. 2, lines 33-35). Stacher further teaches that the surfaces require preparatory cleaning (i.e. pickling) (col. 2, lines 45-47) and states that further application of pressure breaks up the surface oxides to present clean surfaces for bonding (col. 2, lines 53-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined invention of Weisert et al., Salishchev et al., Bampton, and Movchan et al. to include the pickling step of Stacher, in order to remove an accurate amount of oxide to obtain the maximum obtainable joint strength (Stacher; col. 2, lines 50-53) and to significantly lower the cost, difficulty, and time involved in diffusion bonding and superplastic forming titanium alloy structures (Stacher; col. 3, lines 30-36).

With regard to claim 7, Stacher teaches that the surfaces require preparatory cleaning (i.e. pickling) (col. 2, lines 45-47) and states that further application of pressure breaks up the surface oxides to present clean surfaces for bonding (col. 2, lines 53-55). Thus, with the combined invention of Weisert et al., Salishchev et al., Bampton, and Movchan et al., and Stacher, it would have been obvious to arrive at the claimed pickling rate. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined invention of Weisert et al., Salishchev et al., Bampton, and Movchan et al., to include the pickling step of Stacher, in order to

significantly lower the cost, difficulty, and time involved in diffusion bonding and superplastic forming titanium alloy structures (Stacher; col. 3, lines 30-36).

Regarding claim 8, Stacher teaches that the surfaces require preparatory cleaning (i.e. pickling) (col. 2, lines 45-47) and states that further application of pressure breaks up the surface oxides to present clean surfaces for bonding (col. 2, lines 53-55). Thus, with the combined invention of Weisert et al., Salishchev et al., Bampton, Movchan et al., and Stacher, it is obvious to arrive at the claimed amount of oxide to be removed from the surfaces. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined invention of Weisert et al., Salishchev et al., Bampton, and Movchan et al., to include the pickling step of Stacher, in order to remove an accurate amount of oxide to obtain the maximum obtainable joint strength (col. 2, lines 50-53).

With respect to claim 9, Stacher teaches that the surfaces require preparatory cleaning (i.e. pickling) (col. 2, lines 45-47) and states that further application of pressure breaks up the surface oxides to present clean surfaces for bonding (col. 2, lines 53-55). It is noted that Weisert et al. disclose the average thickness of the diffusion bonded sandwich between 5 mils (thousands of an inch) and about 150 mils (Weisert; col. 5, lines 6-10). Thus, with the combined invention of Weisert et al., Salishchev et al., Bampton, Movchan et al., and Stacher, it would have been obvious to arrive at the claimed thickness. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention to include the thickness of Weisert et al., in order to obtain a uniform mass distribution (thickness) of the sheets and therefore

prevent rupturing of the truss core during superplastic forming (Weisert; col. 5, lines 16-19), and further to modify the combined invention of Weisert et al., Salishchev et al., Bampton, and Movchan et al. to include the pickling step of Stacher, in order to significantly lower the cost, difficulty, and time involved in diffusion bonding and superplastic forming titanium alloy structures (Stacher; col. 3, lines 30-36).

***Allowable Subject Matter***

7. Claims 16-23, 36, 38-42, and 46 are allowed.

***Response to Arguments***

8. The examiner acknowledges the applicants' amendment and Information Disclosure Statement (IDS) received by the USPTO on June 10, 2008. The IDS has been considered and initialed, and a copy is provided with this Office Action. Upon review, new double patenting rejections and new 35 US 103(a) rejections are presented in above sections 2 and 5, respectively. Allowable subject matter is newly indicated in above section 7. The applicants have cancelled claims 4 and 37, and have added new claims 45 and 46. Claims 1, 2, 5-12, 16-23, 36, 38-42, 45, and 46 are currently under consideration in the application.

9. Applicants' arguments with respect to claims 1, 2, 5-12, and 45 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571)272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
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